

Application No 8/399,535

C! means for ejecting said plug means from said distal end of said elongated member so as to place said plug means in blocking relation with said puncture, so as to seal said puncture.

REMARKS

After applicants received notification that the above-referenced application had been forwarded to the Board of Appeals for institution of an interference with Lee, U.S. Patent No. 5,292,332, applicants received the February 8, 1999, official action. In that action reconsideration of the previously indicated allowability of all of the claims had been withdrawn in view of a new ground of rejection. Applicants, however, have amended claim 95 above, and it is believed that this amendment clearly overcomes the new ground of rejection, and again places the application in condition for institution of such interference.

The specification has been objected to under 37 C.F.R. § 1.71. The Examiner contends that there is no support in the specification for aspects of the claimed invention specifically citing the fact that claim 95 requires plug means for plugging said puncture being disposed at said distal end of said elongated member. However, in view of the above-noted amendment to claim 95, it is believed that this objection has been obviated.

Claims 95-102 have been rejected as being unpatentable under 35 U.S.C. § 112, first paragraph. The Examiner contends that the claims contain subject matter not described in the specification to enable one skilled in the art to make or use this invention. Referring to the objections to the specification, the Examiner contends that nowhere in the specification is it disclosed that the plug means is disposed at the distal end of the elongated member. The plug is said to be

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disposed at the distal end only during the process of inserting the plug into the puncture, the Examiner contending that even if the specification did recite this feature, this would be an intermediate step in a process and not initial configuration of a device. The Examiner concludes that applicants could not leave out the essential configuration of having the plug inserted in the proximal end before it is at the distal end of the shaft, and therefore this recitation is said to be unsupported in the specification. This rejection is respectfully traversed in view of the above amendments and arguments and for the reasons set forth hereinafter.

Attention is, of course, initially directed to amended claim 95. While claim 95 still clearly corresponds to claim 11 of the Lee patent, it does not now specifically require that the plug means of the claimed device be disposed at the distal end of the elongated member. Instead, the claim merely requires that the plug means be disposed in the elongated member, and that the movable guide means extend longitudinally through the elongated member and the plug means for extension through the puncture for guiding the plug means to the puncture. Again, this corresponds precisely to claim 11 of the Lee patent. While applicants are claiming a device, at the precise moment when the plug means of claim 95 reaches the distal end of the elongated member, it clearly corresponds to the precise embodiment of the Lee invention in which the plug means is initially disposed at the distal end of the elongated member. Thus, while the Examiner contends that applicant does not support a claimed device with the plug means initially located at the distal end of the elongated member, it is submitted that, even if this were the case, and applicants do not admit that it is, the amended claim herein does not require such a specific embodiment. Indeed, the language of claim 11 in the Lee patent is not believed to be so

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limited, but, in any event, is clearly directed to the same invention as that of amended claim 95.

It is therefore respectfully submitted that this objection to the specification and claims has now clearly been obviated, and reconsideration of this objection is now respectfully requested. Indeed, it is believed that this application is clearly in condition for institution of an interference, if for no other reason than the Examiner has again confirmed the fact that claims 103 and 104 directed to the claimed method are allowable and they themselves provide more than adequate basis for institution of an interference with the Lee patent. If, however, for any reason the Examiner stills believes, however, that any of these claims are not in condition for allowance, and/or that an interference cannot be declared, it is respectfully requested that he telephone applicants' attorney at (908) 654-5000 in order to overcome any objections which he might have at this time.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Respectfully submitted,

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